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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,671	12/24/2003	Kia Silverbrook	NPB008US	7891
24011	7590	12/06/2005	EXAMINER LE, KHANH H	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, NSW 2041 AUSTRALIA			ART UNIT 3622	PAPER NUMBER

DATE MAILED: 12/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/743,671

Applicant(s)

SILVERBROOK ET AL.

Examiner

Khanh H. Le

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/14/05</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action is in response to Applicants' Correspondence received 9/14/2005. Amended claims have been entered. Claims 1-14 are now pending. Claims 1 and 8 are independent.

### **Response to Arguments**

2. Contrary to all arguments presented, INTELLIGENT PAPER implicitly suggests the publisher can print both the visible and invisible codes with the invisible code as invisible ink both under or over the visible ink. INTELLIGENT PAPER clearly shows that distributing precoded blank sheets to publishers is not the only solution as argued (see p. 399 1<sup>st</sup> full paragraph.) Visible and invisible codes can be printed. Further printers printing both types of ink are known.

For example, Soscia, US 5996893, discloses methods and apparatus for generating images and/or photographs from digital data files with data, e.g., audio data, stored on the photograph. Ink which is invisible or almost invisible to the human eye but which can be detected using an optical reader is used for printing the data on the photograph. The audio data in invisible ink, may be represented by a bar code, and may be read and played using a hand held scanner. The printer can print both visible and invisible ink. (see at least abstract, Figs. 1-4 and associated text; col. 3 lines 11-35); col. 5 lines 5 l. 30-60).

It would have been obvious to one skilled in the art at the time the invention was made to add the Soscia printers with capabilities of printing both inks and both codes to INTELLIGENT PAPER, so to allow publishers to print the invisible codes together with the visible information as suggested by INTELLIGENT PAPER at see p. 399 1<sup>st</sup> full paragraph.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. **Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Intelligent Paper” by M. Dymetman, and Max Copperman, in Electronic Publishing, Artistic Imaging and Digital Typography, Proceedings of EP ’98, March/April 1998, Springer Verlag LNCS 1375, pp 392-406 in view of Soscia, US 5996893.**

As to claims 1 and 8, “Intelligent Paper” discloses Interactive paper, a method and system for providing content in a printed document or publication, including:

the document or publication having:

thereon human-readable information (e.g. books )

machine-readable coded data (“Intelligent Paper”, page 393, last paragraph: the coded data being invisible; page 392-393, last paragraph, and Fig. 2, p. 396: coded data on surface of paper ; page 2, 2<sup>nd</sup> full paragraph, the intelligent paper is equivalent of touch sensitive screen...)

the human-readable information including at least one user input (interactive) element (hyperlink) which enables the user to indicate a request for further information relating to the content by interacting with the element using a sensing device which is adapted to transmit data indicating the request to a computer system. (see at least pages 392-393),

portions of the machine-readable coded data being indicative of their own position relative to the printed publication (“INTELLIGENT PAPER” page 392, pair: code page-id, pointer-loc).

the computer system storing an e-description of the printed publication and an association between the input element and an associated entity (implied in “Intelligent Paper” so to respond to the request for information)

and wherein the method and system include

Art Unit: 3622

retaining a retrievable record of the printed document, the document being retrievable using the identity data as contained in the coded data ("page-id").

receiving, in the computer system, indicating data from the sensing device, generated from the machine-readable coded data, such indicating data being indicative of a position and a movement of the sensing device relative to the printed publication ("INTELLIGENT PAPER" page 392, pair: code page-id, pointer-loc);

identifying from the indicating data (pointer-loc ; "INTELLIGENT PAPER" discloses the sensing device sensing its movement relative to the document using at least some of the coded data, and identifying the request in the computer system from the movement being at least partially within a zone associated with the interactive element :see e.g., "INTELLIGENT PAPER" page 393, 1<sup>st</sup> full paragraph: "position over the Louvre") and the e-description of the document whether the user has selected the input element using the sensing device ("INTELLIGENT PAPER" page 392, pair: code page-id, pointer-loc).

**monitoring use of the sensing device in the computer system ("Intelligent Paper", page 401, product catalogues).**

and if notifying the associated entity of the selection ( Intelligent Paper" discloses sending information after request from a user over a computing system (see at least p.1-2): notification is thereby at least implied before the sending step).

As to the newly amended limitations, INTELLIGENT PAPER suggests the publisher can print both the visible and invisible codes with the invisible code as invisible ink both under or over the visible ink. INTELLIGENT PAPER clearly shows that distributing precoded blank sheets to publishers is not the only solution as argued (see p. 399 1<sup>st</sup> full paragraph.) Visible and invisible codes can be printed.

INTELLIGENT PAPER does not specifically disclose printers printing both types of ink as claimed.

However, Soscia, discloses methods and apparatus for generating images and/or photographs from digital data files with data, e.g., audio data, stored on the photograph . Ink which is invisible or almost invisible to the human eye but which can be detected using an optical reader is used for printing the data on the photograph. The audio data in invisible ink, may be represented by a bar code, and may be read and played using a hand held scanner. The printer can print both visible and invisible ink. (see at least abstract, Figs. 1-4 and associated text; col. 3 lines 11-35); col. 5 lines 5 l. 30-60) .

It would have been obvious to one skilled in the art at the time the invention was made to add Soscia the printers with capabilities of printing both inks and both codes to INTELLIGENT PAPER so to allow publishers to print the invisible codes together with the visible information as suggested by INTELLIGENT PAPER at see p. 399 1<sup>st</sup> full paragraph.

As to claims 2 and 9, the associated entity is a publisher.

As to claims 3 and 10, the input element is a hyperlink.

As to claims 4 and 11, the associated entity is a publisher computer system.

As to claims 5 and 12 ,“INTELLIGENT PAPER” discloses a catalog (printed publication with a plurality of pages) and wherein the machine-readable coded data on or in the page is indicative of an identity of the page ( “INTELLIGENT PAPER” page 392, code page-id) and of the at least one interactive element (“INTELLIGENT PAPER” page 392, pointer-loc).

As to Claims 6-7 and 13-14,

Intelligent Paper discloses wherein the at least one interactive element is provided in association with the advertising material (Intelligent Paper as printed product catalog with

Art Unit: 3622

catalog items being interactive; also see p. 401, 1<sup>st</sup> full paragraph”: targeted catalogs with user’s addresses). No payment was disclosed in INTELLIGENT PAPER.

However, Official Notice was taken that charging a vendor/advertiser for referral of a potential customer is old and well-known to compensate the referring party. Further charging for clicks of an on-line potential customer is also well-known. Since Intelligent Paper operates as a computer and a source for referrals via user clicks (‘selection of an input element”), it would have been obvious to one skilled in the art at the time of the invention to incorporate charging the beneficiaries of the referrals into the teachings of “Intelligent Paper for the above-discussed advantages. Calculating and notifying a party associated with such charge when a user clicks on an Intelligent Paper would further be obvious to effect eventual completion of such charges.

### Conclusion

5. Prior art made of record and not relied upon is considered pertinent to applicant’s disclosure.

Dymetman et al., US 6330976 B1, discloses intelligent paper.

Buckley et al., US 6,446,871 B1, discloses storing reference codes in writing instrument and thereby retrieving information

Wright, US 4864618 discloses an automated transaction system employs a terminal for printing a value indicia, such as a postmark, on an article. The terminal contains a modular printer unit which has a printhead and a dedicated microprocessor physically permanently bonded together such that the printhead microprocessor cannot be physically tampered with without disabling the printhead. The modular printer unit includes a first supply of visible ink and a second supply of invisible ink, and an internal program for printing the value indicia with visible ink and an authentication code, which uniquely corresponds to the value indicia, with invisible ink. The invisible value indicia can be subsequently verified as authentic by machine

Art Unit: 3622

reading of said invisible authentication code and comparing the authentication code for correspondence to the value indicia, (see at least abstract, col. 4 lines 60 col. 5 lines 10 ).

Nelson et al US 6431448 B1 discloses photo albums with images in visible ink and other data in invisible ink, and printers with both inks.

Berson et al US 5502304 discloses barcode readers to read barcodes made of visible and invisible ink layers.

Knowles US 6942150 discloses scanners to scan url encoded barcodes and directly connect to websites.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The



Art Unit: 3622

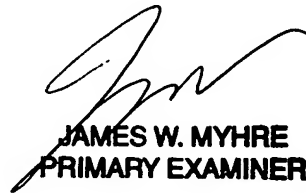
Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600.

November 21, 2005

*KHL*

KHL

  
**JAMES W. MYHRE**  
**PRIMARY EXAMINER**